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10/806,267	03/23/2004	Takashi Ohno	KKP-0276	1916
23353	7590	12/07/2006	EXAMINER	
RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 12/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/806,267

Applicant(s)

OHNO, TAKASHI

Examiner

Callie E. Shosho

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. All outstanding rejections are overcome by applicant's amendment filed 9/25/06.

The new grounds of rejection set forth below are necessitated by applicant's amendment and thus, the following action is final.

**Claim Rejections - 35 USC § 112**

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for wetting regulating agent that is water-soluble denatured silicone oil and antirusting lubricant that is a phosphate ester surfactant, does not reasonably provide enablement for any type of antirusting lubricant or any type of wetting regulating agent. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

Case law holds that applicant's specification must be "commensurately enabling [regarding the scope of the claims]" *Ex Parte Kung*, 17 USPQ2d 1545, 1547 (Bd. Pat. App. Inter. 1990). Otherwise **undue experimentation** would be involved in determining how to practice and use applicant's invention. The test for undue experimentation as to whether or not all compounds within the scope of claims 1-14 can be used as claimed and whether claims 1-14 meet the test is stated in *Ex parte Forman*, 230 USPQ 546, 547 (Bd. Pat. App. Inter. 1986) and

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*In re Wands*, 8 USPQ2d 1400, 1404 (Fed.Cir. 1988). Upon applying this test to claims 1-14, it is believed that undue experimentation **would** be required because:

(a) *The quantity of experimentation necessary* is **great** since claims 1-14 read on any type of antirusting lubricant such as benzotriazole, fatty esters, etc. and any type of wetting regulating agent, i.e. polyhydric alcohol, surfactant, etc.

(b) There is **no direction or guidance presented** for making an ink comprising any type of antirusting lubricant such as benzotriazole, fatty esters, etc. and any type of wetting regulating agent, i.e. polyhydric alcohol, surfactant, etc.

(c) There is an **absence of working examples** concerning making ink comprising any type of antirusting lubricant such as benzotriazole, fatty esters, etc. and any type of wetting regulating agent, i.e. polyhydric alcohol, surfactant, etc.

In light of the above factors, it is seen that undue experimentation would be necessary to make and use the invention of claims 1-14.

4. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 4 has been amended to recite that the acrylic resin has “weight average molecular weight” of 5,000-20,000. It is the examiner’s position that this phrase fails to satisfy the written description requirement under the cited statute since there does not appear to be a written description requirement of the cited phrase in the application as originally filed, *In re Wright*,

866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed

In paragraph 2(a) of the office action mailed 3/23/06, claim 4 was rejected under 35 USC 112, second paragraph given the examiner's position that the scope of the claim was confusing given that it was not clear what type of molecular weight was being referred to – weight average, number average, etc. In response, applicants have amended claim 4 to recite “weight average molecular weight”.

However, while the examiner appreciates applicant response to the previous rejection, there appears to be no support for the recitation of “weight average molecular weight” with respect to the acrylic resin in the specification as originally filed.

**Claim Rejections - 35 USC § 103**

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-6 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ota et al. (U.S. 6,916,862) in view of Hattori et al. (U.S. 2005/0096410) and Kanbayashi et al. (U.S. 6,114,412).

Ota et al. disclose ink for ball-point pen wherein the ink comprises water, 2-10% pigment, 0.1-30% wetting agent that includes combination of two or more wetting agents that include ethanol, propanol, and butanol, and acrylic resin for fixability possessing glass transition

temperature not lower than 50 °C, molecular weight of 1,600-50,000, and acid value of 10-250. It is disclosed that the resin is present in amount not lower than 1/10 of to not higher than 3 times the amount pigment so that it is calculated that the ink comprises 0.02-30% resin. It is disclosed that the viscosity of the ink is not higher than 10 mPas. It is further disclosed that the ink is printed onto non-permeable substrate, i.e. gloss film. Given that Ota et al. disclose the use of two or more wetting agents, it is clear that the wetting agent meets both the requirements of the present claims of alcoholic solvent and wetting regulating agent (col.1, line 24, col.5, lines 45-51, col.7, lines 26-29, col.13, lines 15-19, col.14, lines 1-27, col.20, lines 22-26, col.23, lines 45-51, col.26, lines 21-25 and 62-63, example 10, and col.65, lines 48-51). It is well known, as found in Hattori et al. (paragraphs 6-9), that ethanol, propanol and butanol possess vapor pressure of 45 mmHg or 6 kPa, 14.5 mmHg or 1.93 kPa, and 5.5 mmHg or 0.67 kPa, respectively.

The difference between Ota et al. and the present claimed invention is the requirement in the claims of antirusting lubricant.

Kanbayashi et al., which is drawn to ink for ball point pen, disclose the use of antirusting lubricant that is phosphate ester surfactant in order to enable the ball point of the pen to rotate and to prevent rusting of the tip of the ball point pen (col.4, lines 35-46).

In light of the motivation for using antirusting lubricant disclosed by Kanbayashi et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use antirusting lubricant in the ink of Ota et al. in order to produce ink that enables the ball point of the pen to rotate and to prevent rusting of the tip of the ball point pen, and thereby arrive at the claimed invention.

7. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ota et al. in view of Hattori et al. and Kanbayashi et al. as applied to claims 1-6 and 13-14 above, and further in view of Kobayashi et al. (U.S. 5,678,942).

The difference between Ota et al. in view of Hattori et al. and Kanbayashi et al. and the present claimed invention is the requirement in the claims of specific type of ball-point pen.

Ota et al. disclose the use of ball-point pen comprising ink as presently claimed, however, there is no disclosure of specific type of pen.

Kobayashi et al., which is drawn to ball-point pen, disclose using pen comprising a tip portion of an ink tube and a ball-point pen tip rotatably supporting a ball directly wherein the ink is directly filled in the ink tube. The ball is made of stainless steel. Kobayashi et al. also disclose that the tip includes valve mechanism that presses the ball to the pen tip ridge by a spring impinging on a rear end of the ball that allows the ink to flow out. Kobayashi et al. also disclose using ink following member that is in contact with the end portion of the ink. The motivation for using such pen is to prevent ink flow out and scratchy writing (abstract, col.1, lines 13-38 and 50-62, co.2, line 66-col.3, line 30, col.3, line 1-col.4, line 15, and col.6, line 34-col.7, line 23). Given that Kobayashi et al. disclose using ball made of stainless steel as presently claimed, it is clear that the ball would intrinsically possesses roughness as presently claimed.

In light of the motivation for using specific ball-point pen disclosed by Kobayashi et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such ball-point pen as the pen in Ota et al. in order to prevent ink flow and scratchy writing, and thereby arrive at the claimed invention.

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8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ota et al. in view of Hattori et al. and Kanbayashi et al. as applied to claims 1-6 and 13-14 above, and further in view of either GB 2131445 or Toyoda et al. (U.S. 4,338,133) and Okumura et al. (U.S. 5,268,347).

The difference between Ota et al. in view of Hattori et al. and Kanbayashi et al. and the present claimed invention is the requirement in the claims of water-soluble denatured silicone oil.

GB 2131445, which is drawn to ink for writing instrument, disclose the use of water-soluble polyoxyalkylene silicone oil, i.e. water-soluble denatured silicone oil, as a lubricant so that the ink writes smoothly and to produce characters of even density (page 1, lines 1-9 and 40-44).

Alternatively, Toyoda et al., which is drawn to ink, disclose the use of silicone oil in order to prevent blotting of the ink (col.4, lines 37-39 and 51). The silicone oil is known under the tradename SH-3771 which is well known, as disclosed by Okumura et al. (col.12, lines 30-31), as a water-soluble denatured silicone oil.

Although there is no disclosure in either GB 2131445, Toyoda et al. or Okumura et al. that the water-soluble denatured silicone oil is a wetting regulating agent, given that each reference discloses water-soluble denatured silicone oil identical to that presently claimed, it is clear that the water-soluble denatured silicone oil would intrinsically function as a wetting regulating agent.

In light of the motivation for using water-soluble denatured silicone oil disclosed by GB 2131445 or Toyoda et al. and Okumura et al. as described above, it therefore would have been



obvious to one of ordinary skill in the art to use such water-soluble denatured silicone oil in the ink of Ota et al. in order to produce ink that writes smoothly and produces characters of even density or alternatively, to produce ink that does not blot, and thereby arrive at the claimed invention.

9. Claims 1-6 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ota et al. (U.S. 6,916,862) in view of Hattori et al. (U.S. 2005/0096410), Kanbayashi et al. (U.S. 6,114,412), and either GB 2131445 or Toyoda et al. (U.S. 4,338,133) and Okumura et al. (U.S. 5,268,347).

Ota et al. disclose ink for ball point pen wherein the ink comprises water, 2-10% pigment, 0.1-30% wetting agent that includes combination of two or more wetting agents that include ethanol, propanol, and butanol, and acrylic resin for fixability possessing glass transition temperature not lower than 50 °C, molecular weight of 1,600-50,000, and acid value of 10-250. It is disclosed that the resin is present in amount not lower than 1/10 of to not higher than 3 times the amount pigment so that it is calculated that the ink comprises 0.02-30% resin. It is disclosed that the viscosity of the ink is not higher than 10 mPas. It is further disclosed that the ink is printed onto non-permeable substrate, i.e. gloss film. Given that Ota et al. disclose the use of two or more wetting agents, it is clear that the wetting agent meets both the requirement of the present claims of alcoholic solvent and requirement of wetting regulating agent (col.1, line 24, col.5, lines 45-51, col.7, lines 26-29, col.13, lines 15-19, col.14, lines 1-27, col.20, lines 22-26, col.23, lines 45-51, col.26, lines 21-25 and 62-63, example 10, and col.65, lines 48-51). It is well known, as found in Hattori et al. (paragraphs 6-9), that ethanol, propanol and butanol possess

vapor pressure of 45 mmHg or 6 kPa, 14.5 mmHg or 1.93 kPa, and 5.5 mmHg or 0.67 kPa, respectively.

The difference between Ota et al. and the present claimed invention is the requirement in the claims of (a) antirusting lubricant and (b) wetting regulating agent.

Kanbayashi et al., which is drawn to ink for ball point pen, disclose the use of antirusting lubricant that is phosphate ester surfactant in order to enable the ball point of the pen to rotate and to prevent rusting of the tip of the ball point pen (col.4, lines 35-46).

With respect to difference (b), GB 2131445, which is drawn to ink for writing instrument, disclose the use of water-soluble polyoxyalkylene silicone oil, i.e. water-soluble denatured silicone oil, as a lubricant so that the ink writes smoothly and to produce characters of even density (page 1, lines 1-9 and 40-44).

Alternatively, Toyoda et al., which is drawn to ink, disclose the use of silicone oil in order to prevent blotting of the ink (col.4, lines 37-39 and 51). The silicone oil is known under the tradename SH-3771 which is well known, as disclosed by Okumura et al. (col.12, lines 30-31), as a water-soluble denatured silicone oil.

Although there is no disclosure in either GB 2131445, Toyoda et al. or Okumura et al. that the water-soluble denatured silicone oil is a wetting regulating agent, given that each reference discloses water-soluble denatured silicone oil identical to that presently claimed, it is clear that the water-soluble denatured silicone oil would intrinsically function as a wetting regulating agent.

In light of the motivation for using antirusting lubricant disclosed by Kanbayashi et al. as described above and for using water-soluble denatured silicone oil disclosed by GB 2131445 or

Toyoda et al. and Okumura et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use antirusting lubricant in the ink of Ota et al. in order to produce ink that enables the ball point of the pen to rotate and to prevent rusting of the tip of the ball point pen and to use such water-soluble denatured silicone oil in the ink of Ota et al. in order to produce ink that writes smoothly and produces characters of even density or alternatively, to produce ink that does not blot, and thereby arrive at the claimed invention.

10. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ota et al. in view of Hattori et al., Kanbayashi et al., and either GB 2131445 or Toyoda et al. and Okumura et al. as applied to claims 1-6 and 12-14 above, and further in view of Kobayashi et al. (U.S. 5,678,942).

The difference between Ota et al. in view of Hattori et al., Kanbayashi et al., and either GB 2131445 or Toyoda et al. and Okumura et al. and the present claimed invention is the requirement in the claims of specific type of ball-point pen.

Ota et al. disclose the use of ball-point pen comprising ink as presently claimed, however, there is no disclosure of specific type of pen.

Kobayashi et al., which is drawn to ball-point pen, disclose using pen comprising a tip portion of an ink tube and a ball-point pen tip rotatably supporting a ball directly wherein the ink is directly filled in the ink tube. The ball is made of stainless steel. Kobayashi et al. also disclose that the tip includes valve mechanism that presses the ball to the pen tip ridge by a spring impinging on a rear end of the ball that allows the ink to flow out. Kobayashi et al. also disclose using ink following member that is in contact with the end portion of the ink. The motivation for

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using such pen is to prevent ink flow out and scratchy writing (abstract, col.1, lines 13-38 and 50-62, co.2, line 66-col.3, line 30, col.3, line 1-col.4, line 15, and col.6, line 34-col.7, line 23).

Given that Kobayashi et al. disclose using ball made of stainless steel as presently claimed, it is clear that the ball would intrinsically possesses roughness as presently claimed.

In light of the motivation for using specific ball-point pen disclosed by Kobayashi et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such ball-point pen as the pen in Ota et al. in order to prevent ink flow and scratchy writing, and thereby arrive at the claimed invention.

11. Claims 1-3, 5, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allison et al. (U.S. 6,160,034) in view of Hattori et al. (U.S. 2005/0096410), Kanbayashi et al. (U.S. 6,114,412), and either GB 2131445 or Toyoda et al. (U.S. 4,338,133) and Okumura et al. (U.S. 5,268,347)

Allison et al. disclose ink for roller ball pen wherein the ink comprises 10-90% water, pigment, 15-30% water-soluble latex including acrylic latex, and 3-8% C<sub>2</sub>-C<sub>4</sub> alcohol. It is disclosed that the ink has viscosity of 3-10 cP (col.1, lines 11-15, col.3, lines 6-29, col.7, lines 46-59, col.9, line 65-col.10, line 18, col.11, lines 40-45, col.12, lines 10-12, and col.17, lines 38-42). It is well known, as found in Hattori et al. (paragraphs 6-9), that ethanol, propanol and butanol possess vapor pressure of 45 mmHg or 6 kPa, 14.5 mmHg or 1.93 kPa, and 5.5 mmHg or 0.67 kPa, respectively.

The difference between Allison et al. and the present claimed invention is the requirement in the claims of (a) antirusting lubricant and (b) wetting regulating agent.

With respect to difference (a), Kanbayashi et al., which is drawn to ink for ball point pen, disclose the use of antirusting lubricant that is phosphate ester surfactant in order to enable the ball point of the pen to rotate and to prevent rusting of the tip of the ball point pen (col.4, lines 35-46).

With respect to difference (b), GB 2131445, which is drawn to ink for writing instrument, disclose the use of water-soluble polyoxyalkylene silicone oil, i.e. water-soluble denatured silicone oil, as a lubricant so that the ink writes smoothly and to produce characters of even density (page 1, lines 1-9 and 40-44).

Alternatively, Toyoda et al., which is drawn to ink, disclose the use of silicone oil in order to prevent blotting of the ink (col.4, lines 37-39 and 51). The silicone oil is known under the tradename SH-3771 which is well known, as disclosed by Okumura et al. (col.12, lines 30-31), as a water-soluble denatured silicone oil.

Although there is no disclosure in either GB 2131445, Toyoda et al. or Okumura et al. that the water-soluble denatured silicone oil is a wetting regulating agent, given that each reference discloses water-soluble denatured silicone oil identical to that presently claimed, it is clear that it would intrinsically function as a wetting regulating agent.

In light of the motivation for using antirusting lubricant disclosed by Kanbayashi et al. as described above and for using water-soluble denatured silicone oil disclosed by GB 2131445 or Toyoda et al. and Okumura et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use antirusting lubricant in the ink of Allison et al. in order to produce ink that enables the ball point of the pen to rotate and to prevent rusting of the tip of the pen and to use such water-soluble denatured silicone oil in the ink of Allison et al. in order to

produce ink that writes smoothly and produces characters of even density or alternatively, to produce ink that does not blot, and thereby arrive at the claimed invention.

**Response to Arguments**

12. Applicant's arguments regarding Wang et al. (U.S. 5,76,9931) and EP 964036 have been considered but they are moot in view of the discontinuation of the use of these references against the present claims.

13. Applicant's arguments filed 9/25/06 have been fully considered but, with the exception of arguments relating to Wang et al. and EP 964036, they are not persuasive.

Specifically, applicant argues that Ota et al. is not a relevant reference against the present claims given that there is no disclosure in Ota et al. of wetting regulating agent or antirusting lubricant as presently claimed.

It is agreed that there is no disclosure in Ota et al. of antirusting lubricant which is why Ota et al. is now used in combination with Kanbayashi et al., which teach the use of antirusting lubricant identical to that presently claimed.

While Ota et al. disclose the use of wetting agent, applicants argue that the wetting agent is used for dispersing pigment in aqueous solution to raise the dispersion efficiency of the pigment in the dispersion medium which is in direct contrast to the present invention wherein the wetting regulating agent is used to realize a stable ink wetting on a non-permeable surface.

However, on the one hand, while it is agreed that the wetting agent of Ota et al. is used to raise the dispersion efficiency of pigment in the dispersion medium, the present claims only

require “wetting regulating agent”. There is no requirement in the present claims that the wetting regulating agent is used to realize stable ink wetting on a non-permeable surface. Given that Ota et al. do disclose wetting agent, it is the examiner’s position that Ota et al. met the requirements in the present claims regarding the wetting regulating agent.

On the other hand, Ota et al. is alternatively also used in combination with (in addition to Kanbayashi et al.) either GB 2131445 or Toyoda et al. and Okumura et al., which teach the use of water-soluble denatured silicone oil. Although there is no disclosure that the water-soluble denatured silicone oil is used as a wetting regulating agent, “obviousness under 103 is not negated because the motivation to arrive at the claimed invention as disclosed by the prior art does not agree with appellant’s motivation”, *In re Dillon*, 16 USPQ2d 1897 (Fed. Cir. 1990), *In re Tomlinson*, 150 USPQ 623 (CCPA 1966). Given that GB 2131445 and Toyoda et al. each discloses water-soluble denatured silicone oil identical to that presently claimed, it is clear that the water-soluble denatured silicone oil would intrinsically function as a wetting regulating agent as required in the present invention.

Applicant also argues that Allison et al. is not a relevant reference against the present claims given that there is no disclosure in Allison et al. of wetting regulating agent or antirusting lubricant.

It is agreed that there is no disclosure in Allison et al. of wetting regulating agent or antirusting lubricant which is why Allison et al. is now used in combination with Kanbayashi et al., which teach antirusting lubricant identical to that presently claimed, and either GB 2131445

or Toyoda et al. and Okumura et al. that each teach wetting regulating agent, i.e. water-soluble denatured silicone oil, as presently claimed.

Applicant argues that none of the cited references even suggests that the composition and/or ball point pen disclosed by them is capable of writing on a non-permeable surface.

However, attention is drawn to col.1, lines 20-23 and col.26, lines 62-65 of Ota et al. that disclose that the ink is utilized in ball point pen and is utilized on glossy film, i.e. non-permeable substrate.

Applicant argues that all the examples in Ota et al. disclose utilizing the ink as an ink jet ink that is ejected onto paper. However, “applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others”, *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Further, “nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims”, *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). A fair reading of Ota et al. as a whole as discussed above clearly discloses that while the ink is suitable for use as an ink jet ink, it is equally as suitable for use in ball point pen and while used on paper, is also used on non-permeable substrate, i.e. glossy film.

With respect to Allison et al., it is agreed that there is no disclosure in Allison et al. of ball point pen or writing on non-permeable substrate. However, it is noted that Allison et al. is not utilized against present claims 7-10 that require ball point pen or claim 11 that requires process for using ball point pen on non-permeable surface.



While there is no explicit disclosure in Allison et al. that the ink is “for ball point pen” as required in claim 1, the recitation in the claims that the ink is “for ball point pen” is merely an intended use. Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner’s position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Allison et al. in combination with Kanbayashi et al. and either GB 2131445 or Toyoda et al. and Okumura et al. disclose ink as presently claimed, it is clear that the ink would be capable of performing the recited intended use, i.e. for ball point pen.

### **Conclusion**

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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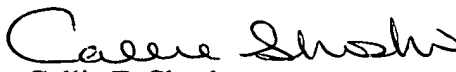
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CS  
12/2/06

  
Callie E. Shosho  
Primary Examiner  
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